

## REMARKS

In the application claims 54-80 remain pending. Claims 1-53 have been canceled without prejudice. No new claims have been added. Various of claims 54-80 have been amended to place the application in better form for appeal should such action be necessary. Support for the amendments may be found in the specification, claims, and figures as originally filed. No new matter has been added. Accordingly, the entry of the amendments into the record of the subject application for patent is respectfully requested.

In the Office Action of October 19, 2004, pending claims 54-62, 64-72, and 74-80 were rejected. The reconsideration of the rejection of the claims is, however, respectfully requested.

More particularly, claims 54-55, 57-59, 62, 66, 71-72, and 76 stand rejected under 35 U.S.C. § 112, second paragraph, since the word “type” appearing in the claims is alleged to be indefinite. In response, it is respectfully submitted that those of ordinary skill in the art will understand the plain meaning of the word “type” as it is used in the claims, i.e., to mean a class of consumer electronic devices such as satellite receiver, TV, VCR, etc. as described at Page 16, lines 17-21 of the subject application for patent. Since this meaning of “type” is in keeping with the plain and ordinary dictionary definition of “type,” it is respectfully submitted that the rejection under 35 U.S.C. § 112, second paragraph, must be withdrawn.

Still further, claims 54-62, 64-72, and 74-80 stand rejected under 35 U.S.C. § 103 as being rendered obvious primarily by Kemink (WO 0017738) in view of O'Donnell (U.S. Patent No. 6,549,143). In response to this rejection, it is respectfully submitted that a prima facie case of obviousness under 35 U.S.C. § 103 requires that the combination of

prior art references disclose each and every element set forth in the claims, considering each and every word. This requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the claimed manner.

The claimed invention is directed to a method of configuring a remote control to command functions of a consumer electronic device. To this end, the claimed method includes, among other things, receiving input that identifies a type and brand of consumer electronic device, using the input that identifies the type and brand of consumer electronic device to select a plurality of command sets that have been identified as being candidates for commanding operations of the specified type and brand of consumer electronic device, and causing the plurality of command sets that have been identified as being candidates for commanding operations of the specified type and brand of the consumer electronic device to be downloaded into a remote control whereby a user may determine by experimentation which of the plurality of command sets is appropriate for commanding operations of the consumer electronic device that is actually owned by the user. As described in the subject application, at page 17, lines 16-23, this method for

configuring a remote control solves, among others, the problem of how to configure a remote control when the user does not have his model number available or when a model number provided is not recognized by the configuring system.

In contrast to the claimed invention, the system and method described in Kemink requires a user to know the model number of a consumer electronic device in order to configure the remote control. In this regard, Kemink describes that the remote control is configured immediately after the downloading has occurred and what is downloaded is the single command set which the configuring system of Kemink identifies, as a function of the specified model number, as being appropriate for commanding the consumer electronic device.

More particularly, the configuring system of Kemink uses a consumer electronic device specific profile to determine the single command set that is to be downloaded into the remote control to configure the remote control to command that consumer electronic device. (*See* Page 6, lines 7-10). The consumer electronic device specific profile is created by a user being “led through a sequence of links and web pages until a manufacturer’s model number is found that corresponds, for example, to the television 251 in FIG. 2.” (*See* Page 6, lines 13-15). While the user may also be presented with a plurality of graphical user interfaces, i.e., nothing more than “selectable buttons, icons, clusters of icons, templates, and the like” (*See* Page 4, lines 31-33) which are actuated to cause select function codes from a command set to be transmitted to an intended target consumer electronic device, one of which is downloadable for use in the remote control (*See* Page 6, lines 15-17, Page 7, lines 18-22), the fact remains that only a single command set, i.e., the single command set which the configuring system of Kemink

determines to be appropriate for the particular consumer electronic device model number specified by the user, is downloaded into the remote control.

Therefore, Kemink, which requires the use of a manufacturer's model number to cause a single command set to be downloaded into a remote control, suffers the very disadvantage the subject invention seeks to overcome.

From the foregoing, it is submitted that the configuring system of Kemink, which uses input that specifies a manufacturer's model number to cause a single command set to be downloaded into a remote control, cannot be said to disclose, teach, or suggest the claimed using a type and brand of a consumer electronic device to cause a *plurality of command sets identified as being appropriate for commanding functions of the specified type and brand of consumer electronic device* to be downloaded into a remote control after which a user [not the configuring system as in Kemink] determines which of the downloaded *plurality of command sets* is appropriate for commanding the consumer electronic device actually owned by the user. (*See* claims 54 and 71).

**It is further respectfully submitted that a prima facie case of obviousness has not been presented since the Office Action fails to assert that Kemink discloses downloading a plurality of command sets identified as being candidates for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device.** Rather, the Office Action sets forth that Kemink discloses at Page 6, lines 10-20, the downloading of "a plurality of GUI corresponding to the selected appliance." While downloading a GUI (i.e., a computer environment or program that displays, or facilitates the display of, on-screen options, usually in the form of icons or menus by means of which users may enter

commands) is the subject of dependent claims 66 and 76, independent claims 54 and 71 of the subject application for patent call for the downloading of a plurality of command sets, defined on Page 14, lines 22-25 of the subject application for patent as including “data which is transmittable to the consumer electronic device to control the device.”

Since it cannot be argued that a GUI is “data which is transmittable to the consumer electronic device to control the device,” Kemink cannot be said to disclose those elements set forth in the Office Action and the rejection of the claims must be withdrawn.

It is additionally submitted that the reason that the Office Action cites to the downloading of a GUI (which is not the subject of independent claims 54 and 71) but fails to cite to any passage from Kemink that can be said to disclose, teach, or suggest that a plurality of command sets identified as being candidates for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device is downloaded into the remote control is for the simple reason that Kemink fails to contemplate this aspect of the claimed invention. That Kemink fails to contemplate this aspect of the claimed invention is particularly evidenced by the fact (which has been acknowledged in the Office Action) that Kemink fails to describe any process for interacting with a remote control to select one of plural downloaded command sets. In this regard, the reason that Kemink fails to describe any process for interacting with a remote control to select one of plural downloaded command sets is attributed to the fact that Kemink only allows for the downloading of a single command set, i.e., a user is required to know in advance the model number of their consumer electronic device and the configuring system of Kemink uses the model number to select the single command set which is downloaded into the remote control.

It is yet further respectfully submitted that, since the system Kemink does not disclose, teach, or suggest downloading a plurality of command sets identified as being candidates for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device, instead disclosing and teaching the downloading of a single command set selected through the use of the user entered model number, there would be no need and no motivation to modify Kemink “to include a user may interact with the remote control to determine by experimentation which one of the plurality of command sets is appropriate” as has been set forth in the Office Action. For this still further reason, it is submitted that the rejection of the claims must be withdrawn.

With respect to dependent claim 59, it is respectfully submitted that the cited to passage from Kemink relating to combining icons fails to disclose, teach, or suggest the claimed downloading of an expanded command set which, as noted above, includes “data which is transmittable to the consumer electronic device to control the device.” For the reason that icon manipulation has nothing to do with data that is transmitted to command functions of a consumer device, it is submitted that the rejection of dependent claim 59 must also be withdrawn.

With respect to dependent claims 58 and 72, it is respectfully submitted that, since Kemink fails to disclose, teach, or suggest the downloading of a plurality of command sets identified as being candidates for commanding operations of the specified type of the consumer electronic device and the specified brand of the consumer electronic device, nothing from within Kemink can be said to disclose, teach, or suggest organizing the downloaded plurality of command sets according to their popularity, i.e., install base. As

such, it is respectfully submitted that dependent claims 58 and 72 further contain subject matter which must be deemed to be patentable.

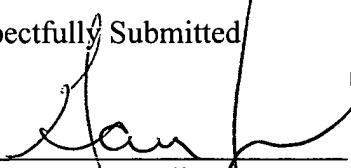
With respect to claims 65 and 75, it is respectfully submitted that nothing from Foster describes, teaches, or suggests the claimed downloading of assignments of function codes to the key layout using a speaker in the downloading process. Accordingly, dependent claims 65 and 75 must be deemed to contain patentable subject matter.

#### CONCLUSION

The subject application is considered to be in condition for allowance. Such action on the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

While it is not believed that any fee is due, the Commissioner is hereby authorized to charge any fee deficiency to deposit account number 50-2428 in the name of Greenberg Traurig.

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